PATENT APPLICATION
Docket No.: 8514-025
Client Ref. No.: ST-A21

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Ned HOFFMAN, et al.	
Serial No.:	09/398,914	Examiner: Evens J. AUGUSTIN
Filed:	September 16, 1999	Art Unit: 3621
Confirmation No.:	1647	
For:	SYSTEM AND METHOD FOR PROCESSING TOKENLESS BIOMETRIC ELECTRONIC TRANSMISSIONS USING AN ELECTRONIC RULE MODULE CLEARINGHOUSE	

Mail Stop Amendment
Commissioner for Patents
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RESPONSE TO NONFINAL OFFICE ACTION DATED APRIL 9, 2007

Responsive to the Office Action, dated April 9, 2007, Paper No. 20070328, for which a two-month extension of time to respond is requested on the accompanying transmittal letter, Applicant traverses the sole remaining rejection -- statutory double patenting -- for the reasons set forth below.

None of the claims are amended, so the claims stand as presented in the communication filed 08 January 2007.

On paragraph 2, page 2, of the Office Action, the Examiner cites Double Patenting as the sole basis for rejecting Claims 1 and 20 under 35 U.S.C. 101. MPEP Section 804 II lists requirements of a Double Patenting rejection, specifically:

"Where the claims of an application are substantively the same as those of a first patent, they are barred under 35 U.S.C. 101 - the statutory basis for a double patenting rejection. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ...." Thus, the term "same invention," in this context, means an invention drawn to *identical* subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957)." (Emphasis added)

Furthermore, "[a] reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other?" MPEP Section 804 II. A.

"On the other hand, claims may be differently worded and still define the same invention." id.

Claims 1-72, 101 and 102 stand rejected solely on "same invention" double patenting grounds under 35 U.S.C. 101. The Examiner specifically rejects pending claims 1 and 20, and then sweeps the other independent claims into the same rejection without stating specific grounds. As the Examiner stated in the Action, citing the first paragraph of MPEP 804 quoted above, the term "same invention" means an invention drawn to *identical* subject matter. Applicant traverses this rejection.

There is confusion in the Action about the prior patent of Applicant as to which the Examiner alleges double patenting in the present claims. In the body of the Action (page 2, paragraph 3) the Examiner points to Applicant's prior US 6,012,039, claims 1, 14 and 15. In the same paragraph the Examiner says "(See appendix A)". Appendix A (pages 4 and 5 of the Action), however, does not refer to claims 1, 14 and 15 of Applicant's prior US 6,012,039. Instead, Appendix A refers to claims 38 and 1 of Applicant's prior US 5,613,012. The undersigned placed a call to the Examiner on 20 August 2007 and left a message for the Examiner to call back and clarify this discrepancy. The Examiner called back the next day and made clear that the double patenting rejection is based only on claims 38 and 1 of Applicant's prior US 5,613,012.

Turning to the rejection thus clarified, applying the standard set forth in the second paragraph of MPEP 804 quoted above, and comparing the claims shown in Appendix A, there is no basis whatsoever for making a double patenting rejection of any kind.

Pending Claim 1

First, comparing claim 38 of prior US 5,613,012 and pending claim 1, several distinctions are readily apparent:

a) In Limitation 1, claim 38 of '012 recites selecting and storing a personal identification code and a private code not used for gaining access to the computer system. Neither of these limitations appear in the corresponding element of pending claim 1.

b) In limitation 2, claim 38 of '012 recites two elements: an execution step wherein a command is processed and executed to produce a determination, and an output step wherein said identification result or determination is externalized and displayed. The Examiner equates these steps to pending claim 1, which recites "formation of a rule module customized to the user in a rule module clearinghouse, wherein at least one pattern data of the user is associated with at least one execution command of the user." Claim 38 of '012 says nothing at all about formation of a rule module, a rule module clearinghouse, or pattern data of a user associated with at least one execution command. Conversely, the recited steps to pending claim 1 claim neither an execution step nor an output step, as required in this limitation of '012 claim 38. Elsewhere in pending claim 1 there is recited a command execution step (element d. of claim 1) but this step invokes a designated rule module (not recited in '012 claim 38) and executes an electronic transmission (also not recited in '012 claim 38.

c) Limitation 3, the comparison step of claim 38 of '012 recites using the personal identification code, which limitation is not contained in pending claim 1.

d) Limitation 4, claim 38 recites that, upon successful identification of the individual, the private code is presented to the individual being identified. This limitation does not appear in pending claim 1. Conversely, pending claim 1 recites that, upon identification of the individual, at least one rule module of the user is invoked to execute at least one electronic transmission. Neither of these features of pending claim 1 appear in '012 claim 38.

Based on the foregoing, it cannot reasonably be said that pending claim 1 is "identical to" '012 claim 38. Applying the test quoted above from *In re Vogel*, it is clear that "claim [1] in the application could be literally infringed without literally infringing a corresponding claim [38] in the patent." Therefore, the double patenting rejection of claim 1 and all other claims rejected on the same basis must be withdrawn.

Pending Claim 20

Applying the same analysis to pending claim 20 relative to '012 claim 1, it is readily apparent that "the claim [20] in the application could be literally infringed without literally infringing a corresponding claim [1] in the patent."

a) Limitation 1: like claim 38 of '012, '012 claim 1 recites a personal identification code and a private code not used for gaining access to the computer system. Neither of these limitations appear in the corresponding element of pending claim 20. Nor does element (h) of '012 claim 1 which displays the private code.

b) In limitation 2, claim 1 of '012 recites two elements: an execution means for processing and execution of commands to produce a determination, and means for output of said evaluation, determination or private code. The Examiner equates these steps to pending claim 20, which recites "an electronic rule module clearinghouse having at least one customizable rule module further comprising at least one pattern data of the user associated with at least one execution command of the user, for executing at least one electronic transmission." Claim 1 of '012 says nothing at all about a customizable rule module, a rule module clearinghouse, or pattern data of a user associated with at least one execution command. Conversely, the recited steps to pending claim 20 claim neither an execution means for producing a determination nor a means for output of said evaluation, determination or private code, as required in this limitation of '012 claim 1. Elsewhere in pending claim 20 there is recited a command execution module (element d. of claim 20) but this module invokes a designated rule module (not recited in '012 claim 1) and executes an electronic transmission (also not recited in '012 claim 1.

c) Limitation 3, the comparison step of claim 1 of '012 recites means for comparison using the personal identification codes, which limitation is not contained in pending claim 20 .

d) Limitation 4, claim 1 of '012 recites execution means for execution of commands for producing a determination. This limitation does not appear in pending claim 20. Instead, the cited limitation of pending claim 20 recites a command execution module for invoking at least one rule module in the electronic rule module clearinghouse to execute at least one electronic transmission. Executing an electronic transmission in pending claim 20 cannot be equated to producing a determination in '012 claim 1. And invoking an execution command associated with at least one pattern data of the user (see Limitation 2, pending claim 20) cannot be found in the execution means of '012 claim 1.

Based on the foregoing, it cannot reasonably be said that pending claim 20 is "identical to" '012 claim 1. Applying the test quoted above from *In re Vogel*, it is clear that "claim [20] in the application could be literally infringed without literally infringing a corresponding claim [1] in the patent." Therefore, the double patenting rejection of claim 20 and all other claims rejected on the same basis must be withdrawn.

Since the Examiner has based the double patenting rejections of all other pending claims on the comparison set forth in Appendix A, and that comparison fails as discussed above the other double patenting rejections are unsupported and should likewise be withdrawn.

In view of the foregoing and the fact that the claims are otherwise allowable, the application should now be in condition for allowance. If any questions remain, the Examiner is requested to called the undersigned.

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Respectfully submitted,
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